REMARKS

Claims 1-16 and 19-22 are currently pending in the instant application. The Examiner has withdrawn the rejection of claims 1-16 in view of the amendment to the claims filed on April 22, 2004. Claims 20 and 21 have been previously allowed. Claims 17 and 18 were previously canceled. Claims 19 and 22 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Patent No. 4,314,156 to Kuppermann et al or UK Patent Application GB No. 2 288 461 A issued to Miles et al, in view of U.S. Patent No. 6,258,301 to Feuerherm et al or U.S. Patent No. 5,804,117 to Baba et al, in further view of U.S. Patent No. 5,254,304 issued to Adachi et al, and in further view of "The Scientist and Engineer's Guide to Digital Signal Processing" S.W. Smith, California Technical Publishing. ISBN: 0-9660176-7-6. 1997. The Applicants traverse the outstanding rejections for at least the reasons presented herein. Reconsideration of the rejections is respectfully requested.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2143.01. There is no teaching in the cited art to combine the references in an attempt to produce the claimed invention. Nor would such a combination have occurred to a person having ordinary skill in the art at the time the invention was made (in 1991). Specifically, Kuppermann teaches an automated analysis system for analyzing samples in biological matrices and providing an indication of identified sample components and their abundances (col. 1, lines 23-29) in order to minimize operator intervention and afford greater reliability of results (col. 1, lines 58-68). Miles teaches a system (spectrometer) for identifying plastics materials, particularly for recycled/scrapped plastics and irregular sized or shaped materials (Abstract, Background). Baba teaches a method for molding resin products constituted by a sheet material that is partially thermally fused onto a substrate surface (col. 1, lines 8-18). Feuerherm teaches a process for blow-molding hollow bodies from thermoplastic

synthetic resin in a manner that minimizes irregularities in the finished products (col. 1, lines 12-14; col. 3, lines 50-63). Smith teaches general digital signal processing concepts. It would not have been obvious to one of ordinary skill in the art at the time of the invention to combine these cited references to produce the features recited in Applicants' claims 19 and 22.

Applicants further maintain that the Examiner has used an improper standard in arriving at the rejection of the above claims under section 103, based on improper hind sight which fails to consider the totality of applicant's invention and to the totality of the cited references. More specifically the Examiner has used Applicant's disclosure to select portions of the cited references to allegedly arrive at Applicant's invention. In doing so, the Examiner has failed to consider the teachings of the references or Applicant's invention as a whole in contravention of section 103, including the disclosures of the references which teach away from Applicant's invention.

In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art "as a whole", not from improper hindsight gained from consideration of the claimed invention. See, *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court

> [n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution.

Id. Also critical to this Section 103 analysis is that understanding of "particular results" achieved by the invention. *Id.*

When, as here, the Section 103 rejection was based on selective combination of the prior art references to allegedly render a subsequent invention obvious, "there must be some reason for the combination other than the hind sight gleaned from the invention itself." *Id.* Stated in another way, "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch* 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

In view of the foregoing remarks and amendments, Applicants submit that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130.

Respectfully submitted,

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